

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

TRANSLATION

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:

Date of mailing **See Form PCT/ISA/210**
(day/month/year) **(sheet 2)**

Applicant's or agent's file reference

PP11748 WO

FOR FURTHER ACTION

See paragraph 2 below

International application No.

PCT/EP2004/053630

International filing date (day/month/year)

21.12.2004

Priority date (day/month/year)

27.01.2004

International Patent Classification (IPC) or both national classification and IPC

D21 F11/00, D21 F9/00, D21 G1/00

Applicant

VOITH PAPER PATENT GMBH

1. This opinion contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|--|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the opinion |
| <input type="checkbox"/> | Box No. II | Priority |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input checked="" type="checkbox"/> | Box No. VI | Certain documents cited |
| <input checked="" type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input checked="" type="checkbox"/> | Box No. VIII | Certain observations on the international application |

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/EP

Authorized officer

Facsimile No.

Telephone No.

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Box No. I Basis of this opinion

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ This opinion has been established on the basis of a translation from the original language into the following language
_____, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material
☐ a sequence listing
☐ table(s) related to the sequence listing
 - b. format of material
☐ in written format
☐ in computer readable form
 - c. time of filing/furnishing
☐ contained in the international application as filed.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

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Box No. V	Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement		
1. Statement			
Novelty (N)	Claims	2-4, 6, 11, 14, 23	YES
	Claims	1, 5, 7-10, 12, 13, 15-22, 24, 25	NO
Inventive step (IS)	Claims	-	YES
	Claims	2-4, 6, 11, 14, 23	NO
Industrial applicability (IA)	Claims	1-25	YES
	Claims		NO
2. Citations and explanations:			
<p>1. Reference is made to the following documents:</p> <p style="margin-left: 40px;">D1: WO-A-0238858</p> <p style="margin-left: 40px;">D2: US-B-6413371</p> <p style="margin-left: 40px;">D3: WO-A-03056102</p> <p style="margin-left: 40px;">D4: WO-A-02103109</p> <p style="margin-left: 40px;">D5: WO-A-0055424</p> <p>2. Document D1 discloses (cf. in particular page 2 lines 5-13; page 13 lines 7-28; page 14 lines 22-30; claim 1; figures 1 and 2):</p> <p style="margin-left: 40px;">"Method for producing a wood-free coated, matte or semi-matte paper web, the paper web being precalendered by means of at least one device for precalendering, thereafter coated at least on one side by means of at least one device for applying a liquid or pasty coating medium, and then dried by means of at least one device for drying, thereby producing a wood-free coated paper web having a roughness in the range of from 0.8 to 3.9 μm [PPS] and a gloss in the range of from 3 to 35% [TAPPI 75°]".</p>			

Box No. V

Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

In this regard it should be noted that the feature "thereby producing a wood-free coated paper web having a roughness in the range of from 0.8 to 3.9 μm [PPS] and a gloss in the range of from 3 to 35% [TAPPI 75°]" describes merely the result to be achieved or the product to be produced (wood-free coated, matte or semi-matte paper), without addressing further method features. In accordance with the wording of present claim 1, therefore, this result comes about as a result of the design of the method set out in the method steps, and hence also by a corresponding method of the prior art according to document D1.

Furthermore, the subject matter of present claim 1 is already known from documents D2 and D3 (see in particular the quotes from the search report).

The method of present claim 1 is therefore not novel over documents D1 to D3 (PCT Article 33(2)).

3. Claim 13 defines a corresponding system suitable for producing wood-free coated, matte or semi-matte paper.

The subject matter of this claim is therefore likewise already known from documents D1 to D3 and is therefore not novel. Furthermore, however, the systems disclosed in documents D4 and D5 for the purpose of producing LWC papers are also suitable for producing wood-free coated papers and are

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Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

therefore prejudicial to novelty in respect of
present claim 13.

4. Dependent claims 2-12 and 14-25 do not appear to contain any features which, in combination with the features of any claim to which they refer back, meet the PCT requirements for novelty and inventive step.

These claims relate to embodiments based on two or more possibilities which in some cases are already known from documents D1 to D5 and are therefore not novel and in other cases are obvious, and from which a person skilled in the art would choose according to the circumstances in order to solve the problem of interest, without thereby being inventive. The design of the corresponding features would fall within the bounds of routine procedure for a person skilled in the art, and would therefore not involve an inventive step.

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Box No. VI

Certain documents cited

1. Certain published documents (Rule 43bis.1 and 70.10)

Application No. Patent No.	Publication date (day/month/year)	Filing date (day/month/year)	Priority date (valid claim) (day/month/year)
D6: DE-A-10255422	24.06.2004	28.11.2002	

2. Non-written disclosures (Rule 43bis.1 and 70.9)

Kind of non-written disclosure	Date of non-written disclosure (day/month/year)	Date of written disclosure referring to non-written disclosure (day/month/year)
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see Form 210

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Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

Pursuant to PCT Rule 5.1(a)(ii), the description should have cited documents D1 to D5 and briefly outlined the relevant prior art disclosed therein.

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Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

1. The feature "thereby producing a wood-free coated paper web having a roughness in the range of from 0.8 to 3.9 μm [PPS] and a gloss in the range of from 3 to 35% [TAPPI 75°]" in claim 1 defines merely the result to be achieved or the product to be produced (wood-free coated, matte or semi-matte paper), without addressing further method features. In accordance with the wording of present claim 1, the product thus described comes about as a result of the design of the method set out in the method steps. This feature does not restrict the subject matter claimed.

2. Claim 6 defines the additional feature "that the paper web, prior to the first application of liquid or pasty application medium, is passed through at least one film press". However, since a film press is always used for applying liquid or pasty application medium, the wording of this claim is inherently contradictory and the subject matter of this claim is therefore not clear (PCT Article 6).